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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.	
10/705,736	11/10/2003	James Marrs	14485.0155US01	4988	
23552 MERCHANT &	7590 05/12/200 & GOULD PC	9	EXAMINER		
P.O. BOX 2903			CAMPBELL, VICTORIA P		
MINNEAPOLIS, MN 55402-0903			ART UNIT	PAPER NUMBER	
			3763		
			MAIL DATE	DELIVERY MODE	
			05/12/2009	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary		Application	Application No. Applica		ant(s)		
		10/705,73	36	MARRS ET AL.			
		Examine	•	Art Unit			
		VICTORIA	A P. CAMPBELL	3763			
Period fo	The MAILING DATE of this communications  Output  Description:	on appears on the	e cover sheet with the	correspondence ad	ddress		
A SH WHIC - Exter after - If NC - Failu Any I	ORTENED STATUTORY PERIOD FOR FOR HEVER IS LONGER, FROM THE MAILING IS IN THE MAILING IS IN THE MAILING IS IN THE MAILING IS IN (6) MONTHS from the mailing date of this communicate to period for reply is specified above, the maximum statutory re to reply within the set or extended period for reply will, by reply received by the Office later than three months after the reply are adjustment. See 37 CFR 1.704(b).	NG DATE OF TH CFR 1.136(a). In no ev ion. period will apply and w y statute, cause the app	HIS COMMUNICATIO ent, however, may a reply be ti ill expire SIX (6) MONTHS fron lication to become ABANDONE	N. mely filed n the mailing date of this of ED (35 U.S.C. § 133).	,		
Status							
1)🖂	Responsive to communication(s) filed on This action is <b>FINAL</b> . 2b)  Since this application is in condition for a closed in accordance with the practice ur	This action is r	on-final. for formal matters, pr		e merits is		
Dispositi	on of Claims						
5)⊠ 6)⊠ 7)⊠ 8)□ <b>Applicat</b> i	Claim(s) <u>1-27</u> is/are pending in the application of the above claim(s) <u>13-27</u> is/are with Claim(s) <u>9-12</u> is/are allowed. Claim(s) <u>1-3 and 5-8</u> is/are rejected. Claim(s) <u>4</u> is/are objected to. Claim(s) are subject to restriction and performance on Papers The specification is objected to by the Example of Example 1 is/are: a) Applicant may not request that any objection is	and/or election raminer. accepted or b) to the drawing(s) t	equirement. ☐ objected to by the be held in abeyance. Se	e 37 CFR 1.85(a).			
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.							
Priority ι	ınder 35 U.S.C. § 119						
<ul> <li>12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).</li> <li>a) All b) Some * c) None of:</li> <li>1. Certified copies of the priority documents have been received.</li> <li>2. Certified copies of the priority documents have been received in Application No.</li> <li>3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).</li> <li>* See the attached detailed Office action for a list of the certified copies not received.</li> </ul>							
2)  Notic 3)  Inform	t(s) e of References Cited (PTO-892) e of Draftsperson's Patent Drawing Review (PTO-94 mation Disclosure Statement(s) (PTO/SB/08) r No(s)/Mail Date <u>11/14/08</u> .	48)	4) Interview Summary Paper No(s)/Mail D 5) Notice of Informal D 6) Other:	ate			

#### **DETAILED ACTION**

This is the second Office Action based on the 10/705736 application filed November 10, 2003. Claims 1-12 as originally filed are currently pending and considered below.

# Specification

1. The disclosure is objected to because of the following informalities:

The description of Figure 13 on Page 2 of the specification references the same figure. A figure can not be an end view of itself.

Appropriate correction is required.

## Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
- 3. Claims 1-3 and 5-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Fischell (US 5,545,143).

Fischell discloses a site for subcutaneous infusion device having a base, a cannula 221 (see figs. 10-12, 15-17), a single unitary diaphragm which has an open end a closed end and a sidewall and an internal reservoir in fluid communication with the cannula through the open end. The base 210 is cylindrical and includes a top side, a bottom side and defines a central aperture extending through the base and including an

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adhesive portion 230. The base 210 further comprises a member having first and second ends wherein the member is positioned in the central aperture of the base and coupled to the first end, an interior wall of the member defining a cavity and the second end of the member being open.

# Allowable Subject Matter

- 4. Claim 4 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
- 5. Claims 9-12 are allowable since the prior art fails to teach a device in combination with all the structural elements and functional relationships and further comprising the base having slots on the top side and the member having a groove along with 8 apertures from the interior wall to the groove.

### Response to Arguments

- 6. Applicant's arguments filed January 9, 2008 have been fully considered but they are not persuasive.
- 7. Regarding applicant's argument that the diaphragm of Fischell is not pierced through a sidewall in order to deliver the medicine, the examiner disagrees. The examiner notes that the closed end of Fischell, which is pierced during both the introduction of the cannula and the delivery of medication, is a sidewall of the device.

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The "upper end" of the diaphragm is as much a sidewall of the diaphragm as any other portion, and therefore a sidewall of the diaphragm is pierced during drug delivery.

#### Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to VICTORIA P. CAMPBELL whose telephone number is (571)270-5035. The examiner can normally be reached on Monday-Thursday, 7-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nicholas Lucchesi can be reached on 571-272-4977. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Victoria P Campbell Examiner, AU 3763

/Nicholas D Lucchesi/ Supervisory Patent Examiner, Art Unit 3763